

particular, original Claims 7 which has now been canceled. Claim 8 has been amended to make it an independent claim.

Claim 8 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In view of the above amending of Claim 8, the rejection under 35 U.S.C. § 112 is deemed overcome and withdrawal of the rejection is respectfully requested.

Claims 1, 2, 5, 6 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Daszkowski.

Applicant respectfully submits that the Daszkowski patent cited by the Examiner as anticipating the invention, does not contain all of the material elements recited in Applicant's present claims. For example, Daszkowski fails to disclose a thermally conductive inlay mat formed from a material having properties that produce a sticky surface as recited in independent Claim 1 (and Claim 8). In view of the above, Applicant submits that the rejection is deemed improper with respect to the present claims since Daszkowski does not satisfy the essential requirement for a proper rejection under 35 U.S.C. § 102.

Claims 2, 5, 6 are dependent on independent Claim 1 and thus depend on subject matter deemed patentable for the reasons set forth above. Allowance thereof is also urged.

Claims 8-10 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Smith et al.

Applicant respectfully submits that the Smith et al patent cited by the Examiner as anticipating the invention, does not contain all of the material elements recited in Applicant's present claims. With particular attention to column 3, lines 1-31, Smith et al teaches a shielded heat sink assembly 40 which includes a metallic heat sink sheet 42, a radiant shield sheet 44 and a generally rectangular resilient silicon heat sink block 46. The heat sink sheet 42 has layers 48, 50 of thermally conductive adhesive material

disposed on its top and bottom sides. Accordingly, Smith et al fails to disclose a thermally conductive inlay mat formed from a material having properties that produce a sticky surface as recited in independent Claim 8. In view of the above, Applicant submits that the rejection is deemed improper with respect to the present claims since Smith et al does not satisfy the essential requirement for a proper rejection under 35 U.S.C. § 102.

Claims 9, 10 are dependent on independent Claim 8 and thus depend on subject matter deemed patentable for the reasons set forth above. Allowance thereof is also urged.

Claims 4, 7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Daszkowski and Claim 11 stand rejected under 35 U.S.C. § 103 as being unpatentable over Smith et al. The Examiner states in the Office Action that specific limitations set forth in Applicant's Claims 4, 7 and 11 would have been a matter of design choice. Applicants respectfully submit that the Board of Patent Appeals and Interferences has decided in Ex parte William R. Garrett (Appeal No. 580-81) that such statements are conclusions and not a reason for an obvious rejection. A copy of this decision is provided for the Examiner's convenience. It is further submitted that the only way the Examiner could have arrived at his conclusion with respect to Claims 4, 7 and 11 is through hindsight analysis by reading into the art the teachings of the Applicant. Hindsight analysis is clearly improper, since the statutory test is whether "the subject matter as a whole would have been obvious at the time the invention was made." Moreover, Claims 4 and 11 depend on subject matter deemed patentable for the reasons set forth above with respect to independent Claims 1 and 8, respectively. Allowance thereof is also urged.

The remaining cited art has been examined, but is not considered more pertinent to patentability than the art discussed above.

The Application with Claims 1-6 and 8-11 is deemed in condition for allowance and such action is respectfully urged. Should the Examiner believe that minor differences exist which, if overcome, would pass the Application to allowance and that said

differences can be discussed in a phone conversation, the Examiner is respectfully requested to phone the undersigned at the number provided below.

Respectfully submitted,

A handwritten signature in black ink, reading "Carlo S. Bessone". The signature is fluid and cursive, with the first name "Carlo" and last name "Bessone" clearly distinguishable.

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Art Unit 245

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Paper No. 13

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PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 580-81

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte William R. Garrett

Application for Patent filed July 29, 1981,
Serial No. 287,769, which is a Continuation-in-Part of
Serial No. 187,350, filed September 15, 1980. Fixed-
Contact Stabilizer.

TC 2800 MAIL ROOM

DEC 27 1980

DEC 27 1980

Frank S. Vaden, III et al. for appellant.

Primary Examiner - Stuart S. Levy
Examiner - D. Werner.

Before Henon, Craig and Lindquist, Examiners-in-Chief.
Lindquist, Examiner-in-Chief.

This appeal is from the final rejection of
claims 1 through 4, 7 through 10, 21 through 25, 27, 31
through 33, 44 through 50 and 52 through 56. Of the
remaining claims in this application, claims 5, 6, 28, 29,
30 and 51 stand withdrawn from consideration and claims 11

Appeal No. 580-81

through 20, 26, and 34 through 43 have been allowed by the examiner.

The invention pertains to a drill string stabilizer which is apparent from a reading of illustrative claim 44, reproduced below.

44. Borehole apparatus comprising
a tubular body having a flow axis,

said body having a plurality of equiazimuthally spaced substantially parallel sides [sic, sided?] slots each extending in a direction having at least a paraxial component, and

blade means received in each slot making an interference fit with the sides of the slot.

The references cited by the examiner are as follows:

Dixon et al. (Dixon)	3,680,647	Aug. 1, 1972
Bassinger	4,106,823	Aug. 15, 1978

All the claims at bar stand rejected under 35 U.S.C. 103 as obvious. As evidence of obviousness, the examiner cites Bassinger as to claims 1 through 4, 21 through 25, 27, 44 through 50 and 52 through 56 and adds Dixon as to claims 7 through 10 and 31 through 33.

Reference is made to the brief and the answer for the respective positions of the appellant and the examiner.

OPINION

We note in passing that "said uppermost blade" in claims 2, 9, 22 and 33 lacks an antecedent basis. As noted in claim 44 reproduced above, it appears to us that "sides" should be "sided" to conform with the interpretation given the claim by the appellant and the examiner. That is to say, the appellant and the examiner have construed claim 44 as calling for plural slots each having substantially parallel sides, and so will we. The

locking means at the ends of the blade components of claim 53 do not appear to be capable of locking with adjacent components and the slot ends.

We have considered the rejection of the claims at bar under section 103 in light of the respective positions of the appellant and the examiner and conclude that it cannot be sustained.

All the claims at bar require that the pockets or slots in the stabilizer body have substantially parallel sides. As disclosed in the paragraphs bridging pages 15 and 16 and pages 20 and 21 of the specification, the appellant means by this language that the pocket or slot sides are at least within a few thousands of an inch of being precisely parallel.

The examiner's contention to the contrary at the bottom of page 4 and the top of page 5 of the answer notwithstanding, sidewalls 21 and 22 of the wear blade supporting grooves of Bassinger are not substantially parallel; each is inclined at an angle of 30° with respect to the other.

The examiner goes on to say at page 5 of the answer that,

"Furthermore, wear blades having parallel sides are notoriously well known in the prior art and one of ordinary skill in the art would, through routine engineering design choice, elect to provide a borehole contacting apparatus with blades having parallel sides."

Since this "prior art" has not been identified and is not before us, we will not comment upon it.


With respect to the proposed modification of the Bassinger structure by further coupling the wear blades to the stabilizer body with screws or bolts of the type

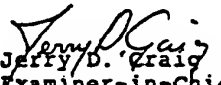
Appeal No. 580-81

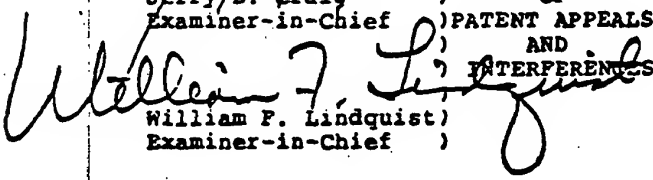
disclosed by Dixon, the examiner has not presented any line of reasoning as to why the artisan would have been motivated to so modify the Bassinger structure, and we know of none. The examiner's assertion at page 4 of the answer that the proposed modification would have been "an obvious matter of engineering design choice well within the level of skill of one of ordinary skill in the art" is a conclusion, rather than a reason.

Accordingly, the rejection of claims 1 through 4, 7 through 10, 21 through 25, 27, 31 through 33, 44 through 50 and 52 through 56 under 35 U.S.C. 103 is reversed.

REVERSED


Paul J. Henon, Jr.)
Examiner-in-Chief)


Jerry D. Craig)
Examiner-in-Chief)


William F. Lindquist)
Examiner-in-Chief)

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